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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,713	07/28/2003	Dennis R. Hughes	20008/G015A	6722

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EXAMINER
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WILLIAMS, JAMILA O

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/628,713	<b>Applicant(s)</b> HUGHES, DENNIS R.	
	<b>Examiner</b> Jamila O. Williams	<b>Art Unit</b> 3722	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8-16-04;10-17-2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear from the claim what is encompassed by the phrase "building-like" structure.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,7,8,10,11,14,15,19,20,26,27,28,29,30,31,32,33,34,35-38,40-42,45 are rejected under 35 U.S.C. 102(b) as being anticipated by 4,946,414 to Zimmer. Zimmer discloses a book comprising a plurality of story panels (10,12,14,16,18,20), wherein each of the story panels is attached to at least another one of the story panels (via tab 10A,B and slots 14A,B for example). Zimmer discloses that at least one panel includes textual information on a first surface (text 60 in figure 3 and col. 2 lines 27-28 which discloses that any panel may have illustrations or reading material thereon) and graphical information on a second surface (see figure 3), wherein at least some of the

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panels are removably attached to the book (via hinge receiving openings, 58A,B for example) and configurable to be assembled to form a structure associated with the textual information and the graphical information is exposed (fig 2), as recited in claim 1.

Zimmer discloses having a first surface that is viewable and a second surface not viewable when the panels are attached in a book (looking at figure 1, which shows the front of the panels in book form. In this view only the first surface of panel 22 is viewable), as recited in claim 2.

Zimmer discloses that the structure is a building like structure (fig 2), as recited in claims 7 and 32 and that the structure comprises the characteristics of a house (fig 2), as recited in claim 8.

Zimmer discloses that the graphical information includes characteristic detail associated with the structure (fig 2), as recited in claim 10.

Zimmer discloses that at least two of the panels are attached to each other (via 10A,B and 14A,B for example), as recited in claim 11.

Zimmer discloses that at least two of the plurality of story panels are configurable to be removed from each other with expected structural results (by removing panel 14 for example the user would be changing the structure of the house, thereby providing expected structural results), as recited in claims 14 and 30.

Zimmer discloses that at least two of the panels are configured to be removed from each other via at least one semi-perforated feature (tab 10A for example is semi-perforated having one section still attached to the panel 10), as recited in claims 15 and 31.

Zimmer discloses that the textual information and graphical information are associated with printed information (see text and graphics in figure 3), as recited in claim 19.

Zimmer discloses a plurality of story panels, a plurality of surfaces associated therewith, including at least one visible surface including textual information (according to col. 2 lines 25-27, any of the panels can be pivoted edge-to-edge about its neighboring panel to expose writing like 60 for example) and at least one hidden surface including graphical information (the exterior surface of the panels shown in the configuration of figure 2 would be hidden when the text is being viewed). At least some of the surfaces are configurable to be assembled to form a structure with the textual information and so that the graphical information is exposed (fig 2), as recited in claim 20.

Zimmer discloses that at least one of the surfaces of the story panels is joined to a surface of another story panel (fig 2), as recited in claim 26 and wherein at least one surface of each of the story panels is attached to the surface of another story panel, as recited in claim 27 and wherein the panels are attached by at least one fastener (tabs and slots of panels constitute a fastener), as recited in claims 28 and 33.

Zimmer discloses that the panels are removably attached to each other (see figure 2 and 3), as recited in claim 29.

Zimmer discloses that at least some of the surfaces include predetermined areas for the at least one fastener (the tabs and slots are located at predetermined areas see fig 3), as recited in claim 34.

Zimmer discloses an article having a plurality of story panels wherein at least some of the panels have at least one visible surface and one hidden surface (see figure 3 panel 16 for example) and wherein the at least one surface of each of the panels is joined to the surface of an adjacent panel (fig 2), as recited in claim 35.

Zimmer discloses that at least one of the plurality of panels includes an inset tab (10A,B for example are inset from the top and bottom of the panel) to facilitate alignment, as recited in claim 36.

Zimmer discloses that the tab is configurable to be accessed on the at least one visible surface (fig 3), as recited in claim 37.

Zimmer discloses that at least some of the surfaces are adhered to each other via a fastener (the tabs and slots constitute a fastener), as recited in claim 38.

Zimmer discloses that each of the panels is formed using a contiguous piece of material and at least one panel is rigid (each panel is made of bristol board material), as recited in claims 40-41.

Zimmer discloses an article comprising a plurality of story panels and a plurality of surfaces associated with the story panels (front and back surfaces of the panels) and including at least one visible surface of textual information and at least one hidden surface of graphical information (according to col. 2 lines 25-27, any of the panels can be pivoted edge-to-edge about its neighboring panel to expose writing like 60 for example, so if you are viewing the interior surfaces of the panels shown in figure 3, then the text will be viewable and the graphical information would be hidden, on the other hand if you are looking at the exterior surface of the panels shown in figure 2, then the

text would be hidden and the graphical information would be viewable.), as recited in claim 42.

Zimmer discloses having at least some of the panels removably attached to each other (fig 2 and 3), as recited in claim 45.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-6,23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmer in view of 1,009,687 to Patton. Zimmer discloses all of the elements of the claims as applied to claim 1 above but does not disclose having panels configurable to form multiple-panel spread, including at least three panels, having unitary construction panels and having a third surface facing a second surface of the panels, as recited in claims 3-6 and 23-25. Patton teaches having a book with multiple panel sheets (fig 3). It would have been obvious to one having ordinary skill in the art to use the multiple-panel teaching of Patton with the panels of Zimmer for the purpose of creating a larger house structure and to provide more textual information.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmer. Zimmer discloses all of the elements of the claims including having textual information on the panels. Zimmer does not however disclose the specifics of that text (assembly instructions, story or game). It would have been obvious to one having ordinary skill in

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the art at the time the invention was made to having story indicia (for example) on the panels since it would depend on the intended use of the assembly. Further it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983).

Claims 12-13,21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmer in view of 2004/0229193 to Wittmeyer, Jr et al (hereinafter Wittmeyer). Zimmer discloses all of the elements of the claims but for using a fugitive adhesive or hot-melt adhesive for adhering at least two of the story panels to each other. Wittmeyer teaches having a book that incorporates hot-melt adhesive for adhering sheets of the book (adhesive 30 and page 3 lines 1-2 of the patent). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the adhesive of Wittmeyer with the panels of Zimmer for the purpose of attaching the panels together.

Claims 16-18,43-44,46-47,48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmer in view of 3,206,887 to Eyler et al (hereinafter Eyler) . Zimmer discloses all of the elements of the claims but for having a panel configurable to form at least a portion of a game board, having text associated with the game and having a semi-perforated features associate with the game attached to the game board. Eyler teaches having a book with sheets or panels that provide a game board area and having indicia thereon for playing the game (driving). Eyler further teaches having semi-perforated features (vehicles shown in figure 3, as shown in the figures only the outline



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of the vehicle is perforated and not the section between the two vehicle halves, therefore making it semi-perforated). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the teaching of Eyler with the panels of Zimmer for the purpose of providing more amusement for the user

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmer in view of 3,548,552 to McBride. Zimmer discloses all of the elements of the claims as applied to claim 35 but does not disclose having a semi-perforated feature associated with the structure including a door. McBride teaches having a book panel with a semi-perforated door (56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the semi-perforated feature of McBride with the door and panel of Zimmer for the purpose of making the structure more realistic.

Claims 49, 52-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmer in view of 1,009,687 to Patton. Zimmer discloses all of the elements of the claims (see rejections above) but does not disclose having panels configurable to form multiple-panel spreads, including a plurality of surfaces having a first and opposing second surface facing the first surface so that the first and second surfaces may be viewed simultaneously. Patton teaches having a book with multiple panel sheets (fig 3) with first and second surfaces that can be viewed simultaneously (fig 1 and 3). It would have been obvious to one having ordinary skill in the art to use the multiple-panel teaching of Patton with the panels of Zimmer for the purpose of creating a larger house structure and to provide more textual or graphical information.

Claims 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmer in view of Patton and further in view of 6,050,604 to Ossiatzky. Zimmer as modified by Patton discloses all of the elements of the claims as applied to claim 49. This combination does not however teach having at least two of the panels removably attached to a common binding edge via a fugitive adhesive or hot melt adhesive. Ossiatzky teaches using hot melt adhesive for binding the edges of a book (col 2 lines 35-38 of the patent to Ossiatzky). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the adhesive of Ossiatzky with the book of Zimmer (modified by Patton) for the purpose of binding the pages of the book.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila O. Williams whose telephone number is 571-272-4431. The examiner can normally be reached on Monday-Friday 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-3484. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JW 5/11/2006

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